

**REMARKS*****Summary of the Amendment***

Upon entry of the above amendment, claims 15 and 31 will have been amended. Accordingly, claims 1 and 4 – 34 currently remain pending. However, as claims 1, 4 – 14 and 21 – 30, directed to the non-elected invention, have been withdrawn from consideration, only claims 15 – 20 and 31 – 34 are currently under consideration by the Examiner.

***Summary of the Official Action***

In the instant Office Action, the Examiner has rejected claims 15 – 20 and 31 – 34 over the art of record. By the present amendment and remarks, Applicants submit that the rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

***Acknowledgment of Telephonic Interview with Examiners Edel and Hug***

Applicants gratefully acknowledge the courtesy extended to their representative by Examiners Edel and Hug in conducting a telephonic interview on March 12, 2007. In the telephone interview, the rejection over the applied document of RUDSZINAT (U.S. Patent No. 3,306,306) was discussed. In the telephone interview, Applicants' representative pointed out RUDSZINAT is directed to a device for connecting a double length filter rod between two tobacco rods to form two filtered cigarettes, not to a device for forming filter rods, which is the subject of the instant invention.

In particular, Applicants representative pointed out RUDSZINAT fails to provide any teaching of arranging part groups of filters in such a manner that the part groups are

adjoined in a lengthwise axial manner, as recited in at least independent claims 15 and 31.

***Traversal of Rejection Under 35 U.S.C. § 102(b)***

Applicants traverse the rejection of claims 15 – 20 and 31 – 33 under 35 U.S.C. § 102(b) as being anticipated by RUDSZINAT. The Examiner asserts RUDSZINAT shows each and every recited feature of the identified claims.

As discussed in the telephone interview, the instant invention is directed to an apparatus and method for producing a filter rod composed of at least two different types of filter segments. According to the invention, the at least two different types of filter segments are assembled into groups that are separated into part groups. The part groups are arranged so the filter segments of the part groups are adjoined in a lengthwise axial manner.

In view of the foregoing, Applicants' independent claim 15 recites, *inter alia*, a *first assembling device* structured and arranged to *assemble the at least two different types of filter segments into groups*, a *separation device* structured and arranged to *divide the groups into part groups*, and a *device* by which the part groups are arranged in such a manner that the *filter segments of the part groups are adjoined in a lengthwise axial manner*. Further, Applicants' independent claim 31 recites, *inter alia*, an *assembling device* coupled to said plurality of filter segment units to *axially align* the produced *plurality of filter segments of different types*, a *separation device* coupled to said assembling device to *divide the axially aligned filter segments into part groups*, and a *device coupled to said separation device* by which the part groups are arranged in such a manner that the *filter segments of the part groups are adjoined in a lengthwise axial*

*manner*. Applicants submit RUDSZINAT fails to disclose at least the above-noted features of the invention.

As shown in Figure 1 of RUDSZINAT, two different types of filter rods are processed, but the two different filter types are not combined together until the white filter (of double length) is inserted between the halved and separated black filter (each of single length). As shown in Figure 2, the black filter is cut by cutter 21 on transfer drum 20 and the two halves are separated on spreader drum 23. Thereafter, the white filter is deposited onto a shuffling drum and the black filter halves are then deposited on the shuffling drum on both sides of the white filter. These three filter pieces are transferred by transfer drum 24 onto second shuffling drum 11 to combine the filter pieces between two tobacco rods. The filter pieces and tobacco rods are wrapped and the double length white filter is subsequently cut by cutter 18 to form two separate filtered cigarettes.

Applicants note that, while positioning a filter segment of one type between a filter material of another type, RUDSZINAT fails to provide any disclosure of a separation device for separating groups to form part groups and a device for arranging the filter parts of part groups to be adjoined in a lengthwise axial manner, as recited in at least independent claim 15. While RUDSZINAT arguably discloses separating a group (composed of the double length white filter and the two single length black filters) into part groups, the group and part groups are connected to tobacco rods. The cut filtered cigarettes are then transported in a direction cross-wise to their axial lengthwise direction. Thus, Applicants submit there is no disclosure or suggestion of arranging part groups in an axial lengthwise manner, as recited in at least independent claim 15.

Further, Applicants submit RUDSZINAT fails to provide any disclosure of a separation device coupled to an assembly device to separate axially aligned filter segments of different type into part groups and a device coupled to the separation device for arranging the filter segments of the part groups to be adjoined in a lengthwise axial manner, as recited in at least independent claim 31. While RUDSZINAT arguably discloses separating axially aligned filter segments of different type (composed of the double length white filter and the two single length black filters) into part groups, these part groups are connected to tobacco rods. As noted above, the cut filtered cigarettes are then transported in a direction cross-wise to their axial lengthwise direction. Thus, Applicants submit there is no disclosure or suggestion of arranging part groups in an axial lengthwise manner, as recited in at least independent claim 31.

As RUDSZINAT fails to disclose at least the above-noted features of the instant invention, Applicants submit this document fails to disclose each and every recited feature of the invention. Thus, Applicants submit the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 102(b), such that this rejection should be withdrawn.

Therefore, reconsideration and withdrawal of the rejection of at least independent claims 15 and 31 is respectfully submitted.

Further, Applicant submits that claims 16 – 20, 32, and 33 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicants submit RUDSZINAT fails to anticipate the invention recited in claims 16 – 20, 32, and 33 of the instant application.

Accordingly, Applicants request the Examiner reconsider and withdraw the rejection of claims 15 – 20 and 31 – 33 under 35 U.S.C. § 102(b) and indicate these claims are allowable.

***Traversal of Rejection Under 35 U.S.C. § 103(a)***

Applicants traverse the rejection of claim 34 under 35 U.S.C. § 103(a) as being unpatentable over RUDSZINAT. While acknowledging RUDSZINAT fails to show the recited transfer conveyor and insertion wheel, the Examiner asserts it would have been obvious to include these elements in the device of RUDSZINAT. Applicants traverse the Examiner's assertions.

As discussed above, RUDSZINAT fails to anticipate the invention recited in at least independent claim 31. Further, Applicants submit, as RUDSZINAT fails to render unpatentable the combination of features recited at least independent claim 31, this document cannot even arguably render unpatentable the invention recited in claim 34. In particular, Applicants note, as RUDSZINAT discloses cutting the groups of filter segments connected between cigarette rods and transporting the cigarette rods in a cross-wise axial direction, there is no arguable suggestion for arranging the filter segments of the part groups to be adjoined in a lengthwise axial manner, as recited in at least independent claim 31.

As the art of record fails to provide any teaching or suggestion for modifying RUDSZINAT in the manner asserted by the Examiner, Applicants submit the applied art fails to render Applicants' invention obvious under 35 U.S.C. § 103(a), such that this rejection should be withdrawn.

Thus, Applicants submit claim 34 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further defines the present invention. In particular, Applicants submit RUDSZINAT fails to render unpatentable the combination of features recited in claim 34 of the instant application.

Accordingly, Applicants request the Examiner reconsider and withdraw the rejection of claim 34 under 35 U.S.C. § 103(a) and indicate these claims are allowable.

***Request for Rejoinder of Non-Elected Claims***

As set forth above, Applicants submit independent claims 15 and 31 have been shown to be allowable over the applied art of record. As claims 1, 8, 11, and 21, which have been withdrawn as directed to the non-elected invention, recite processes of making a filter in the allowable apparatus recited in either independent claim 15 or independent claim 31, Applicants submit all of the features of the allowable apparatus are recited in these process claims.

Accordingly, upon allowance of independent claims 15 and 31, Applicants request rejoinder and consideration of withdrawn claims 1, 4 – 14 and 21 – 30, and an indication that these claims are allowable.

In the Examiner's Restriction Requirement, made final in the previous Office Action, the Examiner acknowledges the inventions are related as process (non-elected invention) and apparatus for its practice (elected invention). Section 821.04(a) of the M.P.E.P. provides

where restriction was required between a product and a process of using the product . . . and the product invention was elected and subsequently found allowable, all claims to a non-elected process must depend from or

otherwise require all the limitations of an allowable claim for the claims directed to that process invention to be eligible for rejoinder.

M.P.E.P. § 821.04(a), 8<sup>th</sup> Ed., Rev. 3, p. 800-64 (August 2005).

As each of the non-elected claims 1+, 8+, 11+, and 21+ recite a process of using the allowable apparatus, such that each of these non-elected claims depends from an allowable claim, the claims are eligible for rejoinder. Accordingly, rejoinder of claims 1, 4 – 14 and 21 – 30 and consideration of the merits of the same by the Examiner is requested.

### ***Application is Allowable***

Thus, Applicants respectfully submit that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

### ***Authorization to Charge Deposit Account***

The undersigned authorizes the charging of any necessary fees, including any further extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

### **CONCLUSION**

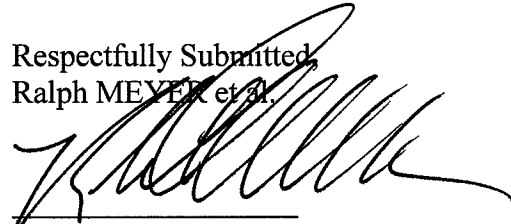
In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicants' invention, as recited in each of claims 15 – 20 and 31 – 34, or as recited in each of the withdrawn claims 1, 4 – 14, and 21 – 30, for which Applicants have requested rejoinder and consideration. The applied references of record have been discussed and

distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully Submitted,  
Ralph MEYER et al.



Neil F. Greenblum  
Reg. No. 28,394

**Robert W. Mueller**  
**Reg. No. 35,043**

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GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191